



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/004,282 | 10/22/2001 | Atsushi Shimizu | 15115/008001 | 3807 |

22511 7590 04/22/2003

ROSENTHAL & OSHA L.L.P.
1221 MCKINNEY AVENUE
SUITE 2800
HOUSTON, TX 77010

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,282

Applicant(s)

SHIMIZU ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Original claims 1-6 have been examined. The rejections are stated below.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfberg et al (US Patent 5745706)

With reference to claim 1, Wolfberg teaches an electronic settlement system for electronically paying a plurality of expenses requested by a user within a predetermined

Art Unit: 3624

period, comprising: deposit processing means for processing a deposit (See Wolfberg Col 2 lines 39-40), payment processing means for processing a payment (See Wolfberg Col 2 lines 39-40), storage means for storing payment method, payment period, scheduled payment amount, and credit limit for each account (See Wolfberg Col 4 lines 21-33) and management means for totaling deposits and payments from a user through the electronic settlement system and informing the user of the totaled amount thereof for each account (See Wolfberg Col 8 lines 51-53). That each account is used to pay a plurality of expenses is inherent in the disclosure and the reports are interpreted to include the total of deposits and payments for each of the plurality of expenses.

With reference to claim 2, Wolfberg teaches an electronic settlement system of claim 1 further comprising a credit limit alteration means for altering credit limit stored by the storage means that is calculated at a time when request of payment by the electronic payment system is received. (See Wolfberg Col 8 lines 55-60). The step of altering the credit limit is understood to be in accordance with the difference between the total deposit amount and total payment amount at a point in time.

With reference to claim 3, Wolfberg teaches an electronic settlement system of claim 1 wherein if the expense requested to be paid by the electronic settlement system is subject to tax deduction, the management means prints out deposits and payments of that expense within a tax fiscal year at an end of that year on an accounting sheet in a manner that the accounting sheet can be used to submit to tax office. (See Wolfberg Col 8 lines 51-53) The reports are interpreted to include tax-deductible expenses report that can be used with the tax returns filing. In the alternative official notice is taken that statement for accounts that include deposits

Art Unit: 3624

and payments of tax deductible expense within a tax fiscal year at an end of that year on an accounting sheet in a manner that the accounting sheet can be used to submit to tax office are old and well known in the art. Such statements facilitate maintaining records for tax purposes and also make filing tax returns easier.

With reference to claim 4, Wolfberg teaches an electronic settlement method for electronically paying a plurality of expenses requested by a user within a predetermined period, comprising storing payment method, payment period, scheduled payment amount, and credit limit of the expense that is requested to pay by the electronic settlement method for each account (See Wolfberg Col 4 lines 21-33), storing a deposit data from a user for each account (See Wolfberg Col 2 lines 39-40) and upon receiving a request to pay by the electronic settlement system, determining whether payment is allowed based on the stored data of deposit and credit limit for the expense (See Wolfberg Col 8 lines 8-17). The steps of paying the requested expense if payment to that request is determined to be allowable, and rejecting the payment if payment to that request is not allowable is old and well known in the art. These steps protect the account holder against fraudulent and unauthorized transactions. That each account is used to pay a plurality of expenses is inherent in the disclosure.

With reference to claim 5, Wolfberg teaches an electronic settlement method of claim 4 further comprising calculating difference between total deposit amount and total payment amount at a time payment is requested to the electronic settlement system, altering credit limit stored in the system based on the difference (See Wolfberg Col 8 lines 55-60), and determining whether payment is allowable to that request of payment to the electronic settlement system (See Wolfberg Col 8 lines 8-17).

Art Unit: 3624

With reference to claim 6, Wolfberg teaches an electronic settlement method of claim 4 printing statement for accounts that list tax-deductible expenses for the tax year at the end of the year. (See Wolfberg Col 8 lines 51-53) The reports are interpreted to include tax-deductible expenses report that can be used with the tax returns filing. In the alternative official notice is taken that statement for accounts that include deposits and payments of tax deductible expense within a tax fiscal year at an end of that year on an accounting sheet in a manner that the accounting sheet can be used to submit to tax office are old and well known in the art. Such statements facilitate maintaining records for tax purposes and also make filing tax returns easier.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
April 20, 2003

 RICHARD WEISBERGER
PRIMARY EXAMINER